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REMARKS

Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1). As will be shown below, Tobita does not anticipate a method, system, or computer program product for administering devices as claimed in the present application. Claims 1-3, 8-10, and 15-17 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-3, 8-10, and 15-17.

Claims 4-7, 11-14, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1) in view of Furukawa, *et al.* (U.S. Pub. No. 2002/0009073A1). As will be shown below, neither Tobita nor Tobita combined with Furukawa teaches a method, system, or computer program product for administering devices as claimed in the present application. Claims 4-7, 11-14, and 18-21 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 4-7, 11-14, and 18-21.

Amendments

In an effort to move the case forward, Applicants have amended the claims by adding three new claims: Independent claim 22 and, depending from new claim 22, dependent claims 23 and 24. The Office Action rejects claim 1 as anticipated by Tobita under 35 U.S.C. § 102(e). The Office Action states in its numbered paragraph 12 that "Tobita does not teach the method [of claim 4] comprising the email message comprising at least one digital object." New claim 22 is a combination of claim 1 and claim 4 that effectively incorporates into the limitations of claim 1 limitations of claim 4 that the Office Action advises are not anticipated by Tobita, thereby creating a claim, new claim 22, not anticipated by Tobita.

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Applicants explain in detail below that in fact Tobita teaches none of the limitations of claim 1, making claim 1 patentable under 35 U.S.C. § 102(e). Applicants present new claim 22 in an effort to advance the case with no prejudice to Applicants' arguments that Tobita discloses none of the elements of claim 1.

New dependent claim 23 is derived from claim 5, which is still in the case. New dependent claim 24 is derived from claim 6, which is still in the case.

In addition, Applicants have amended claim 18 to correct two minor clerical errors. Applicants respectfully submit that these amendments add no new matter to the present application.

Claim Rejections – 35 U.S.C. § 102 Over Tobita

Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1). To anticipate claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Tobita must disclose each and every element as set forth in Applicants' claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The second requirement of anticipation is that Tobita must enable Applicants' claims. *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). Tobita does not meet either requirement and therefore does not anticipate Applicants' claims.

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Tobita Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

The Court of Appeals for the Federal Circuit states in *Verdegaal Bros.* that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros.*, 814 F.2d at 631, 2 USPQ2d at 1053. As explained in more detail below, Tobita does not disclose each and every element of claim 1, and Tobita therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Independent claim 1 claims:

A method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

sending at least one of the email display capability attributes to the sender.

Claims 8 and 15 claim system and computer program product aspects respectively of the method claimed in claim 1. Regarding claims 1 and 8, the Office Action at numbered paragraph 4 states:

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...Tobita teaches a method of email administration comprising the steps of: receiving in a transcoding gateway from a sender an email display capability request, wherein the request comprises a domain identification (Paragraphs [0011-0013] and [0020]); finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain (Paragraphs [0011-0012]); and sending at least one of the email display capability attributes to the sender (Paragraphs [0011], [0013] and [0020]).

The Office Action states that Tobita at paragraphs 0011-0013 and 0020 discloses "receiving in a transcoding gateway from a sender an email display capability request, wherein the request comprises a domain identification...." Applicants respectfully note in response, however, that Tobita at paragraphs 0011-0013 and 0020, actually discloses "a means for receiving an image disclosure request from a mobile phone...." Tobita's means for receiving an image disclosure request from a mobile phone does not disclose receiving in a transcoding gateway from a sender an email display capability request as claimed in the present application.

The Office Action states that Tobita at paragraphs 0011-0012, discloses "finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain...." Applicants respectfully note in response, however, that Tobita at paragraphs 0011-0012 in fact discloses "retrieving a user identifier corresponding to the intrinsic identifier of the mobile phone from the user identifier table...." Again, Tobita's retrieving a user identifier corresponding to the intrinsic identifier of a mobile phone does not disclose finding at least one email display capability record for the domain as claimed in the present application.

The Office Action states that Tobita at paragraphs 0011, 0013, 0020, discloses "sending at least one of the email display capability attributes to the sender...." Applicants

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respectfully note in response, however, that Tobita at paragraphs 0011, 0013, 0020, actually discloses "a mail server for transmitting an electronic mail to the mobile phone." Tobita's mail server for transmitting an electronic mail to a mobile phone does not disclose sending at least one of the email display capability attributes to the sender as claimed in the present application.

In rejecting claim 15, the Office Action at numbered paragraph 8 cites the same arguments mentioned above in rejecting claims 1 and 8. The Office Action further states that Tobita at paragraphs 0096 and 0097 discloses a recording medium. Claim 15 claims:

A computer program product of email administration comprising:

a recording medium;

means, recorded on the recording medium, for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

means, recorded on the recording medium, for sending at least one of the email display capability attributes to the sender.

That is, claim 15 claims a recording medium upon which is recorded means for carrying out the method elements of another claims of the present application. Applicants respectfully submit in response that Tobita at paragraphs 0096 and 0097 actually discloses that "[n]umeral 53 represents a hard disk that stores a user identifier list table." Tobita's hard disk that stores a user identifier list table does not disclose a recording

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medium upon which is recorded means for carrying out the method elements as claimed in the present application.

Tobita does not disclose each and every element of claims 1, 8, and 15. Dependent claims 2-3, 9-10, and 16-17 depend respectively from independent claims 1, 8, and 15. These dependent claims include each and every limitation of the independent claims from which they depend. These dependent claims stand because their respective independent claims stand. The rejections of all claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102, therefore, should be withdrawn. Applicants respectfully traverse the rejection to each of claims 1-3, 8-10, and 15-17 and request claims 1-3, 8-10, and 15-17 be allowed.

Tobita Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Tobita disclose each and every element of the claims 1-3, 8-10, and 15-17 of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Tobita must be an enabling disclosure of each and every element of claims 1-3, 8-10, and 15-17 of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d at 273, 158 USPQ at 600. The meaning of *Hoeksema* for the present case is that unless Tobita places Applicants' claims 1-3, 8-10, and 15-17 in the possession of a person of ordinary skill in the art, Tobita is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

Tobita in fact does not place each and every element of claims 1-3, 8-10, and 15-17 in the possession of a person of skill in the art. The Office Action states that Tobita at

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paragraphs 0011-0013 and 0020 discloses "receiving in a transcoding gateway from a sender an email display capability request, wherein the request comprises a domain identification...." Applicants respectfully note in response, however, that Tobita at paragraphs 0011-0013 and 0020 actually discloses "a means for receiving an image disclosure request from a mobile phone...." Tobita's means for receiving an image disclosure request from a mobile phone does not place in the possession of a person of skill in the art receiving in a transcoding gateway from a sender an email display capability request as claimed in the present application.

The Office Action states that Tobita at paragraphs 0011-0012, discloses "finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain...." Applicants respectfully note in response, however, that Tobita at paragraphs 0011-0012, in fact discloses "retrieving a user identifier corresponding to the intrinsic identifier of the mobile phone from the user identifier table...." Again, Tobita's retrieving a user identifier corresponding to the intrinsic identifier of a mobile phone does not place in the possession of a person of skill in the art finding at least one email display capability record for the domain as claimed in the present application.

The Office Action states that Tobita at paragraphs 0011, 0013, 0020, discloses "sending at least one of the email display capability attributes to the sender...." Applicants respectfully note in response, however, that Tobita at paragraphs 0011, 0013, 0020, actually discloses "a mail server for transmitting an electronic mail to the mobile phone." Tobita's mail server for transmitting an electronic mail to a mobile phone does not place in the possession of a person of skill in the art sending at least one of the email display capability attributes to the sender as claimed in the present application.

In rejecting claim 15, the Office Action at numbered paragraph 8 cites the same arguments mentioned above in rejecting claims 1 and 8. The Office Action further states that Tobita at paragraphs 0096 and 0097 discloses a recording medium. Claim 15 claims:

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A computer program product of email administration comprising:

a recording medium;

means, recorded on the recording medium, for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

means, recorded on the recording medium, for sending at least one of the email display capability attributes to the sender.

That is, claim 15 claims a recording medium upon which is recorded means for carrying out the method elements of another claims of the present application. Applicants respectfully submit in response that Tobita at paragraphs 0096 and 0097 actually discloses that "[n]umeral 53 represents a hard disk that stores a user identifier list table." Tobita's hard disk that stores a user identifier list table does not place in the possession of a person of skill in the art a recording medium upon which is recorded means for carrying out the method elements as claimed in the present application.

Tobita fails to place in the possession of a person of skill in the art each and every element of claims 1, 8, and 15. Dependent claims 2-3, 9-10, and 16-17 depend respectively from independent claims 1, 8, and 15. These dependent claims include each and every limitation of the independent claims from which they depend. These dependent claims stand because their respective independent claims stand. The rejections of all claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102, therefore, should be withdrawn.

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Applicants respectfully traverse the rejection to each of claims 1-3, 8-10, and 15-17 and request claims 1-3, 8-10, and 15-17 be allowed.

Because Tobita neither discloses each and every element of Applicants' claims nor enables Applicants' claims, Tobita cannot anticipate Applicants' claims. Claims 1-3, 8-10, and 15-17 are therefore patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 4-7, 11-14, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1) in view of Furukawa, *et al.* (U.S. Pub. No. 2002/0009073A1). As will be shown below, neither Tobita nor Furukawa, either alone or in combination, teaches or suggests a method, system, or computer program product for administering devices as claimed in the present application. Claims 4-7, 11-14, and 18-21 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 4-7, 11-14, and 18-21.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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Tobita and Furukawa

Claims 4-7, 11-14, and 18-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tobita in view of Furukawa. The proposed combination of Tobita and Furukawa cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination Of Tobita and Furukawa
Does Not Teach all Of Applicants' Claim Limitation

Because as shown above, Tobita fails to disclose any element of claims 1, 8, and 15, the combination of Tobita and Furukawa also fails to disclose each and every element of dependent claims 4-7, 11-14, and 18-21. Because the Office Action cites Furukawa as teaching only additional claim limitations found in dependent claims 4-7, 11-14, and 18-21, the combination of Tobita and Furukawa cannot disclose each and every element of the referenced dependent claims. Claims 4-7, 11-14, and 18-21 are therefore patentable and the rejections under 35 U.S.C. § 103 should be withdrawn.

No Suggestion or Motivation to Combine Tobita and Furukawa

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Tobita and Furukawa. *In re Vaeck*, 947 F.2d at 493, 20 USPQ2d at 1442. The suggestion or motivation to combine Tobita and Furukawa must come from the teaching of the references themselves, and the Examiner must explicitly point to the teaching within Tobita or Furukawa suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910

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F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action makes no mention whatsoever of any place in either of the references that suggests or provides any motivation for the proposed combination of Tobita or Furukawa. Absent such a showing, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. Because the Office Action fails to make a *prima facie* case for obviousness under 35 U.S.C. § 103, the rejections of claims 4-7, 11-14, and 18-21 are improper and should be withdrawn.

No Reasonable Expectation of Success in the
Proposed Combination of Tobita and Furukawa

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Tobita. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The Office Action fails to demonstrate any basis for any reasonable expectation of success in the proposed combination of Tobita and Furukawa. In fact, the Office Action makes no mention whatsoever of reasonable expectation of success in the combination. Tobita at paragraph 0002 generally discloses a system and method for protecting copyrights that prevents images from being disclosed to more than a predetermined number of persons allowed. Furukawa at paragraph 0002 generally discloses a method for terminal-to-terminal communication connection control using an IP transfer network. There can be no reasonable expectation of success in Tobita's system for protecting copyrights by regulating the disclosure of images with Furukawa's method for terminal-to-terminal communications using an IP transfer network. Applicants respectfully submit that it is not functional to graft an affirmative terminal-to-terminal communications function onto a system for exclusion, a system designed to prevent certain communications of graphic images. The two cannot possibly be said to be compatible. The Office Action therefore not only does not assert any reasonable possibility of success in its proposed combination, the Office Action could not possibly make any such assertion. Because the Office Action demonstrates no reasonable

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expectation of success in the proposed combination of Tobita and Furukawa, the combination cannot be used as a foundation for a rejection under 35 U.S.C. § 103.

Neither Tobita nor Tobita combined with Furukawa discloses each and every element of claims 4-7, 11-14, and 18-21. There is no suggestion to combine Tobita and Furukawa in either reference, and there is no reasonable expectation of success in the proposed combination. The Office Action therefore does not establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicants respectfully traverse the rejection to each of claims 4-7, 11-14, and 18-21 and request that claims 4-7, 11-14, and 18-21 be allowed.

Relations Among Claims

Independent claims 8 and 15 claim system and computer program product aspects of the method claimed in claim 1. Claims 8 and 15 therefore are patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-7, 9-14, and 16-21 depend respectively from independent claims 1, 8, and 15. The dependent claims include each and every limitation of the independent claims from which they depend. The independent claims stand because their respective independent claims stand.

Conclusion

Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1). Regarding independent claims 1, 8, and 15, Tobita neither discloses each and every element of Applicants' claims nor enables Applicants' claims. Tobita therefore does not anticipate Applicants' claims. Dependent claims 2-3, 9-10, and 16-17 depend respectively from independent claims 1, 8, and 15. Dependent claims 2-3, 9-10, and 16-17 include each and every limitation of the independent claims from which they depend. Dependent claims 2-3, 9-10, and 16-17 stand because their respective independent claims stand. Claims 4-7, 11-14, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1) in view of Furukawa, *et al.* (U.S. Pub. No.

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2002/0009073A1). Neither Tobita nor Tobita combined with Furukawa establishes a prima facie case of obviousness. The rejection of all claims 1-21 should be withdrawn, and all claims 1-21 should be allowed. Applicants respectfully traverse each rejection individually of claims 1-21 and request reconsideration of claims 1-21 in light of the present remarks.

In addition, Applicants have amended the claims by adding three new claims: Independent claim 22 and, depending from new claim 22, dependent claims 23 and 24. New claim 22 is a combination of claim 1 and claim 4 that Applicants submit is allowable in view of commentary in the Office Action.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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